

REMARKS

Claim 1 has been amended to incorporate the text of claim 5 (which required the presence of 1-15% hydrophobic silica) and to require that the oxyalkylenated compound be a thickening agent. Support for these amendments exist, *inter alia*, in original claim 5 and at page 4, lines 1-4.

Claim 5 has been canceled.

The dependency of claim 4 has been changed from claim 1 to new claim 22.

The Markush group in claim 9 has been amended in an editorial, non-limiting manner.

New claims 23-26 require the presence of a specific amount of hydrophobic silica. Support for these new claims exists, *inter alia*, at page 5, lines 2-3.

New claim 22 corresponds to original claim 9. It also requires that the oxyalkylenated compound be a thickening agent. Support for this claim exists, *inter alia*, in original claim 9 and at page 4, lines 1-4.

New claims 27 and 28 correspond to claims 10 and 11, respectively, except that they depend from new claim 22 rather than claim 1.

New claim 29 requires that the viscosity range from 9-15 Pa·s. Support for this claim exists, *inter alia*, at page 4, line 13.

Claims 1-4 and 6-29 are currently pending.

Application No. 09/903,769
Reply to Office Action of May 5, 2003

The Office Action rejected claims 1-4, 6-8, 12-15 and 21 under 35 U.S.C. § 102 as anticipated by U.S. patent 5,824,296 ("Dubief"), and claims 1-13, 16 and 21 under 35 U.S.C. § 102 as anticipated by EP 514760 ("EP 760"). The Office Action also rejected claims 1-16 and 21 under 35 U.S.C. § 103 as obvious over U.S. patent 6,277,797 ("Glenn") and PCT patent application publication no. WO 96/28140 ("Glenn"). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of these rejections.

Regarding the § 102 rejection based upon Dubief, the Office Action did not reject claims 5 or 9. Claim 1 has been amended to incorporate the text of claim 5. Thus, claims 1-4, 6-21 and 23-24 all require the presence of 1-15% hydrophobic silica. Similarly, new claim 22 corresponds to original claim 9. Thus, claims 22 and 25-28 all require the specific oxyalkylenated compounds set forth in claim 9. Accordingly, all pending claims require the hydrophobic silica content set forth in original claim 5 and/or the specific oxyalkylenated compounds set forth in original claim 9. In view of the above, Applicants respectfully submit that the § 102 rejection based upon Dubief has been obviated and should be withdrawn.

What's more, Dubief's comparative example 2 upon which the Office Action focuses is unsatisfactory (it is reportedly difficult to apply and to remove and has a coarse feel -- col. 6, lines 50-52). Thus, Dubief's comparative example 2 neither teaches nor suggests the claimed cosmetically-acceptable compositions.

Regarding the § 102 rejection based upon EP 760, the Office Action focuses on example 7. Example 7 contains the polymer polymethacryloyloxy ethyl trimethylammonium chloride. This polymer is not a foaming surfactant. Rather, the polymer is a film-forming agent which enables the disclosed compositions to dry after application and to be peeled off

Application No. 09/903,769
Reply to Office Action of May 5, 2003

after drying. (See, page 3, lines 37-40 and page 5, lines 4-7). Accordingly, EP 760's example 7 does not contain the claimed foaming surfactant and, thus, cannot anticipate the claimed invention.

Moreover, example 7's polymer is cationic. In contrast, claim 12 does not encompass cationic compounds. Rather, claim 12 requires the presence of a foaming surfactant selected from the group consisting of nonionic surfactants, anionic surfactants, amphoteric surfactants, and zwitterionic surfactants, and mixtures thereof. For this reason as well claim 12 is neither taught nor suggested by example 7.

Furthermore, EP 760 does not indicate whether the silica in example 7 is hydrophobic or non-hydrophobic. Because it is possible, if not probable, that the silica in example 7 is non-hydrophobic (particularly in view of the fact that silica is not generally hydrophobic), example 7 cannot anticipate the claimed invention which requires the presence of hydrophobic silica. In other words, example 7 does not necessarily contain hydrophobic silica, so it cannot anticipate the claimed invention as a matter of law.

In view of the above, Applicants respectfully submit that the rejections under 35 U.S.C. § 102 are improper and should be withdrawn.

Regarding the § 103 rejections, because both Glenn references claim priority from the same U.S. patent application (serial no. 08/403,619) and, thus, appear to be equivalent, they will be discussed together as "Glenn."

Glenn neither teaches nor suggests the claimed compositions containing the claimed oxyalkylenated thickening agents. As the Office Action indicates (at page 7), Glenn's emulsions are **liquid** (see, abstract, summary of the invention, col. 14, line 16 et seq. of the U.S. patent). Glenn neither teaches nor suggests using oxyethylenated or

Application No. 09/903,769
Reply to Office Action of May 5, 2003

oxyethylenated/oxypropylenated compounds to thicken his liquid compositions. Col. 12, lines 20-24 (of the U.S. patent) relate to lathering surfactants. Col. 13, lines 5-26 (of the U.S. patent) relate to "humectants and solutes" which are water-soluble. Neither of these disclosures relates to oxyalkylenated thickening agents. Rather, these disclosures relate to adding compounds which lather and/or maintain the liquid nature of Glenn's compositions.

Based on Glenn's disclosure, one skilled in the art would not be motivated to use oxyalkylenated thickening agents, but rather compounds which lather or maintain the liquid nature of compositions. In other words, no motivation would exist to modify Glenn's liquid compositions to yield the claimed compositions containing oxyalkylenated thickening agents.

In view of the above, Applicants respectfully submit that the rejections under 35 U.S.C. § 103 are improper and should be withdrawn.

Regarding the Restriction Requirement, Applicants respectfully submit that withdrawing claims 17-20 from consideration is improper. Each of these claims depends from claim 1, so it is appropriate to examine these claims with the remaining claims in the application. Upon indication that allowable subject matter exists in this application, Applicants intend to seek rejoinder of claims 17-20 prior to issuance.

Finally, submitted herewith is a Terminal Disclaimer over co-pending application serial no. 09/903,785, filed July 13, 2001.

Application No. 09/903,769
Reply to Office Action of May 5, 2003

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Richard L. Treanor
Registration No. 36,379

Jeffrey B. McIntyre
Registration No. 36,867



22850

Phone #: (703) 413-3000
Fax #: (703) 413-2220